REMARKS/ARGUMENTS

Claims 1 - 23 are pending in this application.

Restriction Requirement

In the Office action mailed August 3, 2004, the Office restricted the application to the following groups of claims:

I. Claims 2-8, drawn to compounds wherein R3 is piperidine, classified in class 546, subclass 197. If this group is elected, claims 1 and 9-19 can be prosecuted with together with the elected compounds to the extend that R3 is piperidine.

II. Claims 1, 9-19, drawn to compounds wherein R3 is morpholine, classified in class 544, subclass 105.

III. Claims 1, 9-19, drawn to compounds wherein R3 is pyrrolidinyl, classified in class 548, subclass 465.

IV. Claims 1, 9-19, drawn to compounds wherein R3 is nonheterocyclic, classified in class 549, subclass 399.

V. Claims 20-23, drawn to a method of treating cancer, classified in class 514, subclass various, depending on species election. If this group is elected, a further election of a single disclosed cancer and a single disclosed compound for treating the elected cancer is also required.

Election

Applicant elects group I, *i.e.*, claims 2-8 and generic claims 1 and 9-19 to the extent that R3 is piperidine, *with traverse.*

The Office makes the case that the claims of groups I, II, III, IV, and V are distinct or independent:

> Groups I-IV compounds are independent and distinct because the core structure has been evidenced not to be the substantial structure for the common utility since similar core with different substituents are known for entirely unrelated utility, i.e., see X is nitrogen compounds (CA 126) for treating arteriosclerosis while X is SO2 compounds (CA 99) are useful for PCA inhibition. Groups I-IV compounds thus differ in elements, chemical bonding and chemical properties to such an extend that a reference anticipating one group would not render another group obvious. Further, the classification for each group are not coetensive of each other and separate searches must be conducted.

> Inventions I-IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product as evidenced by Ito US 4,960,908.

(Office Action, page 2, last paragraph to page 3, first paragraph.)

Applicant submits that restriction is not proper in this instance. MPEP § 803 states the requirement for a *proper* restriction.

> There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed; **and (B) There must be a serious burden on the examiner if restriction is required.**

(MPEP § 803, citations omitted, emphasis added.) Thus, there are *two* requirements for restriction: independence or distinctness ***and*** a serious burden. Both are required; independence or distinctness without a serious burden is not sufficient to justify restriction. Section 803 explicitly sates that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though in includes claims to independent or distinct inventions."

Applicant respectfully submits that restriction is not proper in this case. While the claims of Groups I, II, III, IV, and V may satisfy the Office's requirements for distinctness or independence, their consideration would hardly result in a serious burden on the Office.

If issues relating to this application can be resolved by discussion, the Examiner is invited to contact the undersigned attorney by telephone.

Respectfully submitted,

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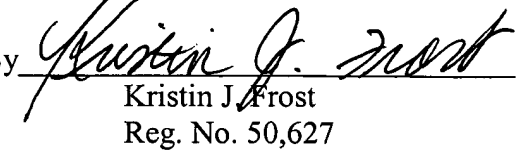
By 

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